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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,412	06/12/2000	GUNTHER SCHNEIDER	BEIERSDORF6	9863

7590

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1619

DATE MAILED: 01/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/581,412

Applicant(s)

SCHNEIDER ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of Amendment filed on October 12, 2001. Claims 11-40 are pending.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 11-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahms et al. (U.S. Pat. No. 5,744,062) ("Dahms") in view of Aronson et al. (U.S. Pat. No. 4,606,913) ("Aronson") and Kurtz et al. (SOFW J., 1997, 123(3)) ("Kurtz").

The rejection is maintained for the reasons of record.

Response to Arguments

Applicant's arguments filed on October 12, 2001 have been fully considered but they are not persuasive.

1. Applicants argue that Dahms does not contemplate that an emulsion could be stabilized in the absence of an acyl lactylate compound. Examiner takes the position that the presence of acyl lactylate in Dahms or the fact that acyl lactylate is the primary emulsifier in Dahms' invention is irrelevant to the issue of whether it would have been obvious to a skilled worker to select the emulsifiers and electrolytes of the instant claims in formulating an emulsion. It is also noted that the instant claims do not exclude the presence of other components besides the claimed emulsifiers.
2. Applicants argue that Dahms does not suggest any optimal amount for the coemulsifier components and that only the amount of acyl lactylate may be optimized by

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an artisan. Examiner respectfully disagrees. Generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. See MPEP 2144.05 (II). The court in in re Alert also held that “where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” See 220 F.2d 454, 456, 105 U.S.P.Q. 233, 235 (C.C.P.A.) 1955. In this case, Dahms provides general teaching that glyceryl monostearate and cetostearyl alcohol may be used in any ratio, as stated in the previous rejection. Examiner maintains the position that the discovery of the optimal weight range of the coemulsifiers by routine experimentations would have been obvious to a skilled worker.

3. Applicants also argue that the teaching of Dahms does not render the selection of the specific emulsifiers of the instant claims obvious. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner maintains the position that given the general teaching of the suitable emulsifiers in Dahms, one having ordinary skill in the art would have looked to the prior art such as Kutz for specific emulsifiers that are low in skin irritancy and effective in hydration.

4. Applicants argue that Aronson is not combinable with Dahms because, while Aronson teaches high internal phase emulsion (“HIPS”), the inventions of Dahms and applicants are directed to low or medium phase emulsions. Examiner respectfully disagrees. While applicants rely on the teaching of “radically different properties”

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between HIPE's and low or medium internal phase emulsions in Aronson, col. 1, lines 17 – 32, examiner notes that these properties are specifically directed to the fluidity of the emulsions. Examiner takes the position that the teaching of the mechanical difference of HIPE's and low or medium internal phase emulsions in Aronson does not necessarily negate the teaching or suggestion to employ electrolytes to stabilize an emulsion, especially when the invention in Aronson also employs the conventional emulsifiers also used in low or medium phase emulsions. Moreover, applicants' claims are not limited to low or medium internal phase emulsions.

5. Applicants also argue that neither of Aronson or Dahms offers the "requisite motivation or suggestion" for making the substitution proposed in the rejection.

Examiner respectfully disagrees. Aronson attributes the increased stability of its emulsion to the incorporation of electrolytes. See col. 8, line 15 – col. 9, line 10, line 60. As also stated in the rejection, examiner maintains the position that a skilled worker who are given the teaching of both Dahms and Aronson, which are analogous arts, would have been motivated to add electrolytes to Dahms' emulsion in expectation that such modification would result in increased stability of the emulsion.

6. Applicants also argue that the application of Kutz is improper. Examiner respectfully disagrees, as the reference specifically teaches the beneficiary characteristics of the particular emulsifiers at issue. The emulsifiers are specifically for use in cosmetic O/W emulsion, and examiner maintains the rejection based on Kutz.

The full translation of the article is enclosed.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
December 27, 2001


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